

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/539,409

**REMARKS**

This Amendment, submitted in response to the Office Action dated February 3, 2004, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-33 remain pending in the application. Claims 1-8 and 16-23 remain rejected under 35 U.S.C. § 102 as being anticipated by Wang (previously of record). Claims 9-13 and 24-28 remain rejected under 35 U.S.C. § 103 as being unpatentable over Wang. Claims 14-15 and 29-31 have been rejected under 35 U.S.C. § 103 as being unpatentable over Wang in view of newly-cited Wislocki (U.S.P. 4,933,670). Claims 32-33 are allowable over the art of record but are objected to for depending on rejected base claims.

Applicant submits the following arguments in traversal of the prior art rejections.

As an initial matter, Applicant would submit that the finality of the Office Action should be withdrawn. Notably, the substance of claims 6 and 21 was originally pending to describe that positional information and measurement result information are embedded in the radiation image. It was previously submitted that such features are not taught in Wang. In the "Response to Arguments" section, the Examiner now concedes that the embedding of positional and measurement data is not taught in Wang. Detailed Action, page 4, lines 5-11. However, the Examiner contends the feature is obvious. The Examiner is essentially conceding that the anticipation rejection is incorrect but states a new ground of rejection based on obviousness for originally filed subject matter. Therefore, Applicant would submit that the rejection must be made on a non-final basis.

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Similarly, where the Examiner previously relied on Wang and Official Notice to reject claims 14-15 and 29-30, the Examiner now sets forth a formal rejection based on Wang and newly applied art, even though the subject matter of claims 14-15 and 19-20 were previously before the Examiner.

Therefore, Applicant would submit the finality of the Office Action is improper and that the additional proposed claims be entered as a matter of course.

The Examiner's present rejection largely repeats statements previously of record, but includes a clarification of the Examiner's rationale and further provides a response to previously submitted arguments. Applicant would maintain that the anticipation rejection is not supported for at least the following four reasons.

First, Applicant would acknowledge the Examiner's clarification that a radiation image refers to a digitized image 40. Detailed Action, page 2, lines 14-16. The image 40 clearly lacks measuring points, which is a recited claim feature. Even under the Examiner's interpretation of a marker (56-59) corresponding to measuring points, the markers are not part of the radiation image. The Examiner's continued reliance on the markers does not support the rejection.

Second, the measuring point of the independent claim is for measuring geometric features of the object in the radiation image. The Examiner relies on the "markers" for teaching the measuring points, and the geometric feature as corresponding to the breast outline of Wang. However, the cited breast outline does not appear in the cited radiation image 40, but in an entirely separate annotation image 55. Additionally, the disclosed markers provide no information relative to the contour outline as the Examiner appears to suggest. Rather, the

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markers 56-69 correspond to statistical and probability processing (not geometric) of image data, which become separately located from the radiation image. Col. 6, lines 7-13.

In Wang, the markers are used to indicate the abnormalities in the image. Specifically, in Wang, the markers, which are interpreted by the Examiner as measuring points, are not related to the breast outline, which is interpreted by the Examiner as the geometric feature. Thus, one of the characteristic features to the present invention, that is, measuring points are designated for measuring geometric features of an object, would not have been anticipated by Wang.

Third, and relatedly, the Examiner combines the annotation image and radiation image to support the rejection. Even with the combination, the disclosure of Wang still only provides a radiation image separate from the annotated image. For example, when displayed, the radiation image occupies one segment of the screen and includes no markers, and the annotation image occupies a separate segment of the screen. Even when output together, the data is separately maintained. At no point are the markers incorporated into the radiation image. Contrary to the Examiner's suggestion, there is no inclusion of the annotation image (or markers) with the radiation image. By contrast, the claim describes that the radiation image includes the measurement points.

Since in the present invention (as described by claims 6 and 21), the measuring points are embedded into the radiation image, a simple displaying device, which does not have the function of displaying a plurality of images at the same time or a composite image composed of a plurality of images, can be used to display the radiation image with the measuring points.

Fourth, the Examiner contends that the radiation image is inherently stored along with the annotation map. The Examiner contends that this results due to display of the images. However,

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as discussed above, the displays are of separate images. There is no requirement that the annotation image is stored along with the radiation image. Given the separate display areas (450, 55) and separate monitors (300, 450) for output of the radiation image and the annotation image, the radiation image is just as likely to be separately stored from the annotation image. The Examiner's conclusion about storage characteristics for the two separate images is speculative and cannot support an anticipation rejection. Claim 1 is patentable for at least these reasons.

Because independent claim 16 includes analogous recitations, claim 16 is patentable for all the reasons set forth above for claim 1. The remaining claims are patentable based on their dependency, as none of the secondary rejections make up for the above deficiencies.

With further regard to claims 5-6 and 20-21, as discussed above, the Examiner concedes that the anticipation rejection is not supported. The Examiner contends that it would be obvious to embed the positional information and measurement result. However, embedding the data would obscure the original radiation image, thereby making it difficult to analyze the radiation image. Therefore, one skilled in the art would not embed the data, and the Examiner's proffered rationale for the modification of Wang is not supported.

With regard to the rejections over the new combination of Wang and Wislocki, the secondary reference does not overcome the deficiencies noted above for Wang. Therefore, claims 14-15 and 29-30 are patentable.

Applicant has added claims 34-37 to describe features of the invention more particularly.

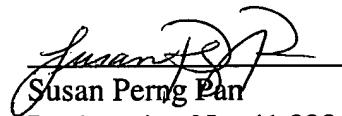
In view of the above, Applicant submits that claims 1-37 are in condition for allowance. Therefore it is respectfully requested that the subject application be passed to issue at the earliest

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possible time. The Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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